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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/787,389	02/27/2004	Rie Miyazaki	Q80155	4816
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SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			DOTE, JANIS L	
			ART UNIT	PAPER NUMBER
			1756	

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Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/787,389	<b>Applicant(s)</b> MIYAZAKI ET AL.	
	<b>Examiner</b> Janis L. Dote	<b>Art Unit</b> 1756	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 5-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicants' submission filed on May 15, 2006.

2. The examiner acknowledges the cancellation of claims 1-4 and the amendments to claims 5 and 7 set forth in the amendment filed on May 15, 2006. Claims 5-8 are pending.

The substitute specification filed on May 15, 2006, has been entered.

3. The objection to claim 7 set forth in the office action mailed on Dec. 15, 2005, paragraph 7, has been withdrawn in response to the amendment to claim 7 set forth in the amendment filed on May 15, 2006.

The rejection of claims 1 and 3 under 35 U.S.C. 102(b)/103(a) over WO 02/084408 A1 (Matsumura), as evidenced by applicants' admissions, set forth in the office action mailed on Dec. 15, 2005, paragraph 10, has been mooted by the cancellation

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of claims 1 and 3 set forth in the amendment filed on May 15, 2006.

4. The indicated allowability of claims 5-8 is withdrawn in view of the amendment to the claims filed in US Application 10/787,394 (Application'394) on Mar. 8, 2006, and on further review of US 2005/0100807 A1 (Yamazaki). Rejections based on the newly cited references follow.

5. The disclosure is objected to because of the following informalities:

(1) The use of trademarks, e.g., Bontron [sic: BONTRON] in the substitute specification filed on May 15, 2006, at page 98, line 12, and Henschel mixer [sic: HENSCHEL MIXER] at page 73, lines 13 and 23, have been noted in this application. The trademarks should be capitalized wherever they appear and be accompanied by the generic terminology. This example is not exhaustive. Applicants should review the entire specification for compliance.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any

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manner which might adversely affect their validity as trademarks.

(2) The misspelling "BONTORON" in the term "BONTORON S-34" at page 52, line 21, of the substitute specification filed on Sep. 28, 2005. The originally filed specification at page 52, line 21, disclosed the term "Bontron S-34."

(3) The figure number "1" in the phrase "Fig. 1 is a drawing typically showing a measuring instrument of viscoelasticity of a toner" (emphasis added) should be changed to the number -- 4 --.

Appropriate correction is required.

Applicant's arguments filed on May 15, 2006 with respect to the objections in items (1) and (2) above have been fully considered but they are not persuasive.

Applicants assert that the substitute specification filed on May 15, 2006, overcomes the objection set forth in item (1) above.

However, for the reasons discussed in the objection in item (1) above, the substitute specification did not capitalize all of the trademarks disclosed in the specification.

The substitute specification did not address the objection set forth in item (2) above, which was previously presented in

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the office action mailed on Dec. 15, 2005, paragraph 4,  
item (2).

6. The following is a quotation of the second paragraph of 35  
U.S.C. 112:

The specification shall conclude with one or more claims particularly  
pointing out and distinctly claiming the subject matter which the applicant  
regards as his invention.

7. Claims 5-8 are rejected under 35 U.S.C. 112, second  
paragraph, as being indefinite for failing to particularly point  
out and distinctly claim the subject matter which applicant  
regards as the invention.

Claims 5 and 7 are indefinite in the term "[a]n image  
forming system" because it is not clear what is meant by the  
term, which is not defined in the originally filed  
specification. Nor is there any disclosure in the specification  
that a person having ordinary skill in the electrophotographic  
arts would readily understand what the term meant.

8. The following is a quotation of the first paragraph of 35  
U.S.C. 112:

The specification shall contain a written description of the invention, and  
of the manner and process of making and using it, in such full, clear,  
concise, and exact terms as to enable any person skilled in the art to  
which it pertains, or with which it is most nearly connected, to make and

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use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 5-8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Instant claims 5 and 7 recite an "image forming system comprising an image-forming apparatus; and a toner . . . ." (emphasis added).

The originally filed specification does not provide an adequate written description of such a system. The originally filed specification provides a description of image-forming apparatuses recited in instant claims 5 and 7, wherein those apparatuses use the particular toners recited in instant claims 5 and 7, respectively. See, for example, the originally filed specification, page 6, line 11, to page 8, line 1. The originally filed specification at pages 6 to 8 states that the "image forming apparatus is equipped with an oil-less fixing unit comprising a main heating member and a pressing member

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. . .” There is no description of “an image forming system” as recited in the instant claims. The claim language “image forming system comprising . . .” encompasses more than the originally described image forming apparatuses and the particular toners because it is open and therefore encompasses other non-described components, such as a box of paper or a human operator.

10. Applicant's arguments filed on May 16, 2006, applicable to the 112 rejections set forth in paragraphs 7 and 9 above have been fully considered but they are not persuasive.

Applicants assert that the “term ‘image forming system’ is not new matter since it merely renames the invention as a system comprising an image forming apparatus and toner . . . and since the term ‘system,’ which is defined as a group of interrelated, interactive or interdependent constitutes forming a complete whole or a functionally related group of elements . . . is to be given its plain and ordinary meaning as would be understood by those of ordinary skill in the art.”

Applicants’ assertion is not persuasive. For the reasons discussed in paragraph 9 above, the claim language “image forming system comprising . . .” is open and encompasses more than the originally described image forming apparatuses and the



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particular toners. In other words, the claim language is broader than the originally described image forming apparatus and toners. Thus, it is not merely a renaming of the originally described image forming apparatus and toners, as asserted by applicants.

In addition, as discussed in paragraph 7 above, the originally filed specification does not provide any disclosure that would have led a person having ordinary skill in the electrographic art to readily determine what is meant by the term "image forming system." Furthermore, applicants have not provided a copy of their source for their definition of the term "system." Moreover, for the reasons discussed above, the term "image-forming system" is not merely a renaming of the originally disclosed image forming apparatuses and toners; it is broader than the combination of the two described components.

11. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

12. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,490,429 B2 (Okayasu'429) combined with US 6,300,024 B1 (Yusa), as evidenced by applicants' admissions at page 6, lines 3-7, and page 109, line 8, to page 110, line 7,

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of the originally filed specification; and Tables 1B and 2B at pages 107 and 108, respectively, of the originally filed specification (applicants' admission I).

Okayasu'429 discloses an electrophotographic image forming apparatus that meets the structural components recited in instant claim 7, but for the particular toner. The apparatus comprises a development device, which develops an electrostatic image with a toner, and a fixing device, which fixes a transferred toner image on a recording material. Col. 5, lines 7-30. The fixing device comprises a heat fixing roller **41** and a pressure roller **45**, which press-contacts the peripheral surface of the heat fixing roller to form a nip portion through which the recording material is inserted. Fig. 4; col. 12, lines 18-32; col. 14, lines 9-39; and example 1 at cols. 21-23. In the nip portion, the pressing roller **45** is depressed, i.e., the surface of the heating roller protrudes towards the pressing roller, which meets the nip boundary surface limitation recited in instant claim 7. See Fig. 4. The heat fixing roller in example 1 comprises a PFA release layer having a layer thickness of 30  $\mu\text{m}$ . According to Okayasu'429, the PFA release layer is used for oil-less fixing. Col. 12, lines 18-32. In example 1, no release oil is used in the exemplified fixing. Okayasu'429 discloses that the fixing device in example 1 provided fixed

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toner images with no paper wrinkles and without the occurrence of uneven fixation. Col. 22, lines 61-64.

Okayasu'429 does not exemplify the particular toners recited in the instant claims. However, Okayasu'429 does not limit the type of toner used.

Yusa discloses a toner comprising a polyester resin and 2 wt% of a polyethylene wax, i.e., a release agent. See example 1, cyan toner A, at cols. 55 and 56. The amount polyethylene wax is within the releasing agent amount of "3 wt% or less" recited in instant claim 8.

According to Yusa, its toner exhibits good low-temperature fixing with "substantially no oil" and anti-high temperature offset characteristic. The toner provides image having an appropriate gloss in a wide temperature range. Col. 6, lines 50-53, 56-57, and 63-65; col. 7, lines 1-6; and example 1, col. 57, lines 9-30.

Yusa does not disclose that the toner has the relaxation modulus properties recited in instant claim 7. However, Yusa discloses that in a oil-less fixing device, the toner exhibits a low temperature fixability of 115°C and a region of no offset between 115 to greater than 200°C, i.e., a no-offset-temperature range greater than 85°C. The toner also provides OHP (overhead projection) images having excellent transparency. No winding of

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the "PPC" paper around the fixing roller was observed. Col. 57, lines 8-17; col. 58, lines 40-46 and 51-54; and Table 5 at col. 61, example 1. These properties appear to the same properties sought by applicants.

The originally filed specification at page 6, lines 3-7, discloses that the "object of the present invention is to provide a toner capable of effectively repressing hot offset of a toner in fixing characteristics, while effectively preventing the winding of a recording medium round a fixing member."

The originally filed specification shows that in an oil-less fixing device, toners that meet the relaxation modulus limitations recited in instant claim 7 and the amount of the releasing agent recited in instant claim 8 exhibited no winding of paper around the pressing roller, no-offset in a temperature range of 130 to 195°C, 145-200°C, or 140-200°C, and provided images with "good transparency." See Table 1B at page 107 of the instant specification, examples 1B to 5B; and page 109, lines 8-17.

Toners that do not possess the relaxation modulus limitations recited in instant claim 7, but which meet the amount of the releasing agent recited in instant claim 8, provided images with "good transparency," but exhibited winding of paper around the pressing roller and no-offset in a narrower

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temperature range than the toners of examples 1B to 5B, i.e., of 140 to 150°C, 130-165°C, or 130-170°C. See Table 2B at page 108, comparative examples 1B to 3B; and page 109, line 17, to page 110, line 7.

Thus, because the toner disclosed in Yusa appears to have the same properties sought by applicants, it is reasonable to presume that the toner disclosed by Yusa has the relaxation modulus properties recited in instant claims. The burden is on applicants to prove otherwise. In re Fitzgerald, 205 USPQ 594 (CCPA 1980).

It would have been obvious for a person having ordinary skill in the art, in view of the teachings of Yusa, to use the toner disclosed by Yusa as the toner in the developing unit of the image forming apparatus disclosed by Okayasu'429. That person would have had a reasonable expectation of successfully obtaining an electrophotographic oil-less image forming apparatus that exhibits good low-temperature fixing and anti-high temperature offset characteristic and provides image having an appropriate gloss in a wide temperature range, as disclosed by Yusa.

Okayasu'429 does not teach that the heat fixing roller contacts the side of the recording medium opposite the side on which the toner is provided to fix the toner at the nip portion

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as recited in instant claim 7. However, the recitation of what side of the recording medium the heating member contacts is merely functional language describing how the apparatus functions. For the reasons discussed supra, the image forming apparatus rendered obvious over the combined teachings of Okayasu'429 and Yusa, as evidenced by applicants' admissions, meet all of the structural element limitations of the image forming system recited in the instant claims. The recitation does not distinguish the structural elements in the instantly recited image forming system from those in the apparatus rendered obvious over the cited prior art. "Claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function." MPEP 2114 and cases cited therein. "A claim containing a 'recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus' if the prior art apparatus teaches all the structural limitations of the claim." MPEP 2114, citing Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

13. Claim 5 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US 5,391,450 (Nagatsuka), as evidenced by applicants'

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admissions at page 6, lines 3-7, and page 89, line 8, to page 90, line 11, of the originally filed specification; and Tables 1A and 2A at pages 87 and 88, respectively, of the originally filed specification (applicants' admission II).

Nagatsuka discloses an electrophotographic image forming apparatus that meets the structural components recited in instant claim 5. The apparatus comprises a development device **34Y**, which develops an electrostatic image by the use of toner, and a fixing device, which fixes a transferred toner image on a recording material. Fig. 6, and col. 18, lines 1-12 and 51-54; and example 1 at cols. 19-20 and in Tables 1 and 2. The fixing device comprises a heat fixing roller **11** and a pressure roller **12**, which press-contacts the peripheral surface of the heat fixing roller to form a nip portion through which the recording material is inserted. Fig. 2 and col. 20, lines 41-43. In the nip portion, the heat fixing roller **11** is depressed, i.e., the surface of the pressure roller **12** protrudes towards the heat fixing roller, which meets the nip boundary surface limitation recited in instant claim 5.

Nagatsuka does not explicitly disclose that its fixing device is an "oil-less" fixing device as recited in instant claim 5. However, Nagatsuka does not state that an oil is applied to any of the rollers in its fixing device in example 1.

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Thus, it is reasonable to conclude that the fixing device in example 1 of Nagatsuka is an oil-less fixing device. The burden is on applicants to prove otherwise. Fitzgerald, supra.

In example 1, the developing device **34Y** comprises a toner comprising a binder resin and a paraffin wax, i.e., a release agent. According to Nagatsuka, its toner exhibits good low-temperature fixing and anti-high temperature offset characteristic and resistance to winding of the transfer medium around the fixing roller. Col. 3, lines 62-68; col. 4, lines 1-3; and Table 2, example 1. The toner in example 1 exhibited a low temperature fixability of 115°C and a region of no offset between 115 to 175°C. The toner also provided OHP (overhead projection) images having excellent transparency. The toner exhibited "excellent" resistance to the winding of the recording medium around the fixing roller. See Table 2.

Nagatsuka does not disclose that the toner has the relaxation modulus properties recited in instant claim 5. However, as discussed supra, the toner in example 1 exhibited various properties. These properties appear to be the same properties sought by applicants.

The originally filed specification at page 6, lines 3-7, discloses that the "object of the present invention is to provide a toner capable of effectively repressing hot offset of



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a toner in fixing characteristics, while effectively preventing the winding of a recording medium round a fixing member."

The originally filed specification shows that in an oil-less fixing device, toners that meet the relaxation modulus properties recited in instant claim 5 exhibited no winding of paper around the pressing roller, no-offset in a temperature range of 130 to 195°C, 145-200°C, or 140-200°C, and provided images with "good transparency." See Table 1A at page 87 of the instant specification, examples 1A to 5A; and page 89, lines 8-17.

Toners that do not possess the relaxation modulus properties recited in instant claim 1 exhibited winding of paper around the pressing roller and no-offset in a narrower temperature range than the toners of examples 1A to 5A, i.e., of 140 to 150°C, 130-165°C, or 130-170°C. See Table 2A at page 88, comparative examples 1A to 3A; and page 89, line 18, to page 90, line 11.

Thus, because the toner disclosed in Nagatsuka appears to have the same properties sought by applicants, it is reasonable to presume that the toner disclosed by Nagatsuka has the relaxation modulus properties recited in instant claim. The burden is on applicants to prove otherwise. Fitzgerald, supra.

Nagatsuka does not teach that the heat fixing roller

contacts the side of the recording medium opposite the side on which the toner is provided to fix the toner at the nip portion as recited in instant claim 5. However, the recitation of what side of the recording medium the heating member contacts is merely functional language describing how the apparatus functions. For the reasons discussed supra, the image forming apparatus disclosed by Nagatsuka, as evidenced by applicants' admissions, meets all of the structural element limitations of the image forming system recited in the instant claims. For the reasons discussed in paragraph 12 above, which is incorporated herein by reference, the recitation does not distinguish the structural elements in the instantly recited image forming system from those in the apparatus disclosed by the cited prior art.

14. Claims 7 and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by US 2005/0100807 A1 (Yamazaki), as evidenced by applicants' admissions I.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be

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overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Yamazaki discloses a toner comprising 100 parts by weight of a polyester binder resin, a colorant, and 2 parts by weight of carnauba wax, i.e., a release agent. See paragraphs 0383-0398; example 11 at paragraph 0411 and in Table 1 at page 31. The polyester binder resin comprises two components: 15 parts by weight of polyester block copolymer B'; and 85 parts by weight of amorphous polyester resin A. The amount of carnauba wax is within the releasing agent amount recited in instant claim 8.

Yamazaki does not disclose that the toner has the relaxation modulus properties recited in instant claim 7. However, as discussed supra, the Yamazaki toner meets the toner compositional limitations recited in instant claims 7 and 8. Yamazaki also discloses that the toner exhibits good fixability for a temperature range of 120-210°C with no occurrence of offset. Yamazaki, paragraph 0437 and Table 3, example 11. These properties appear to be the same properties sought by applicants.

The originally filed specification at page 6, lines 3-7, discloses that the "object of the present invention is to provide a toner capable of effectively repressing hot offset of a toner in fixing characteristics, while effectively preventing the winding of a recording medium round a fixing member." The discussion of applicants' admissions I in paragraph 12 above is incorporated herein by reference.

Thus, because the Yamazaki toner meets the toner compositional limitations recited in the instant claims 7 and 8 and because the Yamazaki toner appears to have the same fixing properties sought by applicants, it is reasonable to presume that the toner disclosed by Yamazaki has the relaxation modulus properties recited in instant claim 7. The burden is on applicants to prove otherwise. Fitzgerald, supra.

Yamazaki further discloses its toner can be used in an image forming apparatus comprising a developing unit **60** and an oil-less fixing unit comprising a heating roller **210** and a pressing roller **220**. See Fig. 5, and paragraphs 0308-0311 and 0319. The developing unit **60** contains the toner. The heating roller **210** and pressing roller **220** form a nip part, where the pressing roller is depressed, i.e., the surface of the heating roller protrudes towards the pressing roller, which meets the nip boundary surface limitation recited in instant

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claim 7. See Fig. 8, and paragraphs 0322-0323.

Yamazaki does not teach that the heating roller contacts the side of the recording medium opposite the side on which the toner is provided to fix the toner at the nip portion as recited in instant claim 7. However, the recitation of what side of the recording medium the heating member contacts is merely functional language describing how the apparatus functions. For the reasons discussed supra, the image forming apparatus disclosed by Yamazaki, as evidenced by applicants' admissions, meets all of the structural element limitations of the image forming system recited in the instant claims. For the reasons discussed in paragraph 12 above, which are incorporated herein by reference, the recitation does not distinguish the structural elements in the instantly recited image forming system from those in the apparatus rendered obvious over the cited prior art.

15. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re*

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*Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

16. Claims 7 and 8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, and 7 of copending Application No. 10/787,394 (Application'394), as evidenced by that portion of the disclosure in Application'394 that supports the claimed subject matter in claims 1, 2, and 7 of Application'394, and applicants' admissions in examples 1A and 1B and Tables 1A and 1B of the instant specification.

The claims in Application'394 are those filed on Mar. 8, 2006. The examiner notes that a notice of allowability was mailed in Application'394 on Apr. 27, 2006.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed subject matter in Application'394 renders obvious the toner recited in the instant claims.

Reference claim 7 covers an image forming system comprising an image forming apparatus comprising an oil-less fixing unit that meets the oil-less fixing unit recited in instant claim 7 and a toner. The toner has an "initial relaxation modulus  $G(t=0.01)$  [Pa] of the toner at 120°C, in relaxation time of 0.01 sec, of  $G(t=0.01)$  (Pa)  $\geq 1.0 \times 10^5$  [Pa]," which meets the  $G(t=0.01)$  at 120°C range of  $\geq 1.0 \times 10^5$  Pa recited in instant claim 7. Reference claim 2, which depends on reference claim 1, recites the toner having the limitations recited in reference claim 7 and further requires that the toner comprise a releasing agent in an amount of 3 wt% or less, which meets the toner composition limitation recited in instant claim 8. The claims of Application'394 do not recite that the toner has an initial relaxation modulus  $G(t=0.01)$  at 180°C, in relaxation time of 0.01 sec,  $\geq 1.0 \times 10^4$  Pa as recited in instant claim 7. However, that portion of Application'394 that supports the toner recited in reference claim 7 teaches that such a toner provides results in winding, "good region of offset," and transparency (HAZE) that are the same or similar to the results obtained from a

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toner that supports the toner recited in instant claims 7 and 8 disclosed in the instant specification. See Application'394, Table 1A, toner 1A; and the instant application, Table 1B, toner 1B. In addition, toner 1A in Application'394 comprises a toner binder resin that is similar to that used in toners 1A and 1B in the instant specification. Toner 1A in Application'394 is also made by process steps that are the same as those used to make the toner 1B in the instant specification. When addressing the use of whether a claim in the application defines an obvious variation of an invention claimed in a patent, "those portions of the specification which support the patent claims may also be examined and considered." See MPEP 804,II.B.1, p. 800-22, citing In re Vogel, 164 USPQ 619, 622 (CCPA 1970). Thus, because the toner disclosed in Application'394 that supports the toner recited in reference claims 2 and 7 exhibits the same properties as the toners that support the toners recited in instant claim 7 and 8 disclosed in the instant specification, it is reasonable to presume that the toner claimed in Application'394 has an initial relaxation modulus  $G(t=0.01)$  at 180°C as recited in instant claim 7. In other words, the two toners appear to be the same material. The burden is on applicants to prove otherwise. Fitzgerald, supra.



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It would have been obvious for a person having ordinary skill in the art, in view of the subject matter claimed in Application'394 and that portion in Application'394 that supports the subject matter claimed in Application'394, to make and use a toner as recited in the instant claims and to use the resultant toner in the image forming system recited in the claims of Application'394. That person would have had a reasonable expectation of successfully obtaining an image forming system that comprises a toner that is capable of forming fixed toned images using an oil-less fixing device.

The claims of Application'394 do not recite that heating member contacts the side of the recording medium opposite the side on which the toner is provided to fix the toner at the nip portion as recited in instant claim 7. However, the recitation of what side of the recording medium the heating member contacts is merely functional language describing how the apparatus functions. For the reasons discussed supra, the image forming apparatus recited in the claims of Application'394, as evidenced by applicants' admissions, meets all of the structural element limitations of the image forming system recited in the instant claims. For the reasons discussed in paragraph 12 above, which are incorporated herein by reference, the recitation does not distinguish the structural elements in the instantly recited

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image forming apparatus from those in the apparatus rendered obvious over the subject matter recited in the claims of Application' 394.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janis L. Dote whose telephone number is (571) 272-1382. The examiner can normally be reached Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, Mr. Nam Nguyen, can be reached on (571) 272-1342. The central fax phone number is (571) 273-8300.

Any inquiry regarding papers not received regarding this communication or earlier communications should be directed to Supervisory Application Examiner Ms. Claudia Sullivan, whose telephone number is (571) 272-1052.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Jun. 26, 2006

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